

B13  
(cont.)

a binder for containing [a plurality of said album leaves] said album leaf, said album having a plurality of retaining means for holding items containing the [original] first source of the images contained in said album leaf.

B14

53.(Once amended) A system for displaying, storing and retrieving images according to claim 52 wherein said icon comprises a silhouette of said plurality of images provided on said first image retaining section of said first side, an image ID, and an origination ID, said image ID and said origination ID being associated with said at least one of said plurality of images, said origination ID indicating said first source and said image ID indicating the location of said image on said first source.

SUB  
C23  
B15

57.(Twice amended) A system according to claim 52 wherein a second icon is formed on said first image retaining section of said first side for identifying a second source of a second image of said plurality of images on said first side, said second source being different from said first source.

SUB  
C24  
B16

58.(Once amended) A system according to claim 52 wherein said second image retaining section of said second side is also provided with a plurality of images and a second icon for identifying the source from which at least one of said plurality of images on said second side originated.

#### Remarks

The Examiner of the Official Action has noted that informal drawings are currently on file. Upon the finding of allowable subject matter, Applicant will submit appropriate formal drawings to be substituted for those currently on file.

The Examiner has also noted an informality with regard to claim 35 with regard to the word "the". By this amendment this typographical error has been corrected.

The Examiner in the Official Action rejected claims 13-36 under 35 USC § 112, second paragraph for the reasons set forth in paragraph 4. By this amendment applicants have amended the claims to overcome these objections. It

is respectfully submitted that these claims have overcome the objections set forth therein.

The Examiner has rejected the claims under 135 USC § 103(a) for the reasons set forth in the paragraphs 6, 7, 8 and 9.

Applicant would first like to thank the Examiner for the telephone interview granted applicant's attorney on June 23, 2000 and follow up call on June 26, 2000. During the interview applicant discussed the present invention and the distinguishing features over the cited prior art. The Examiner referred to Fig. 9a-c of U.S. 5,764,870.

Applicants pointed out that the prior art did not teach or suggest the invention as set forth in the independent claims. In particular, the present invention is directed to an album leaf and system for storing and retrieving images which includes the album leaf. An album leaf according to the present invention has an image retaining section on both sides of the leaf. Support for this amendment is found on page 5, lines 5-15 of the present application. The independent claims have been amended to more clearly define and distinguish the present invention over the prior art.

The main references upon which the claims have been rejected are US patent 5,791,692 and US patent 4,903,068 to Shiota. As discussed in the telephone interview, the '692 reference is an example of a prior art album to which the present invention is directed. In particular, the present invention is directed to the placement of icons thereon which identify the source from which images came. The icons are on the same side as the images being illustrated. In contrast, the Shiota reference is directed to a printing operation for printing images onto a web which are then cut into individual prints as is typically not done in the prior art. Applicants refer the Examiner to column 6, lines 36-39 which clearly states that the printed strip is cut into individual prints and delivered to tray 9. Furthermore, the Shiota reference is not directed to an album leaf to which the present invention is directed. An album leaf according to the present invention, has an image retaining section on both sides of the page. See page 5, lines 5-15 of the present application. Thus, images may be provided on both sides of the leaf. This is clearly not possible in the '068 reference as all the images are printed on the same side of the web. Furthermore, the index print which includes numeral

60a is separated from the web. There are no icons in Shiota on the same page on which the images displayed are taught and claimed by applicant. Furthermore, as illustrated by Fig. 2 of the present invention, the sources may be from two separate and distinct sources. For example, the two icons illustrated in Fig. 2 illustrate that certain images are from one roll of film and the other three images are from a different roll of film. This is clearly not taught or suggested by the prior art. Thus, there are numerous features provided by the present invention that are not taught or suggested by the prior art. As previously discussed, the Shiota reference is not directed to an album leaf nor does it teach or suggest the placement of icons on the same sheet in which the images are displayed as taught and claimed by applicant. The Shiota reference is directed to nothing more than the providing of individual prints on a web that is cut into individual prints. There is no teaching or suggestion for providing the invention as taught and claimed by applicant.

The Examiner in paragraph 7 discusses U.S. 5,764,870 and refers specifically to Figs. 9a-9c. The '870 reference is directed to a method of making an index print using a folder wherein individual cut strips of film are placed and exposed to make the index print of Figs. 9a-9c. The index print may have an ID indicating where the images originated. However, this ID refers first to the entire strip of film, not to each of the images. Additionally, there is no suggestion of providing image retaining section on the back side as taught and claimed by applicant. Exposing of the holder with the film would only form images on one side. Further, the icons in the present invention include identifying the location of the images on the side of the leaf and the source of each of the images. It is respectfully submitted that this reference is of little relevance to the present invention.

The Examiner in paragraphs 8 and 9 discuss further references in rejecting various dependent claims. None of these additional reference teach or suggest the providing of icons as taught and claimed by applicant.

Furthermore, there are numerous other features as set forth in applicants dependent claims which are taught or suggested. For example, in claim 2 which is dependent upon independent claim 1, there is taught and suggested the providing of a silhouette of the images on the icon. This is used for identifying

the individual images on the side of the leaf so it can be directly related to the source from which it was originated. None of the references teach or suggest the providing of a silhouette on the same page in which the image is provided.

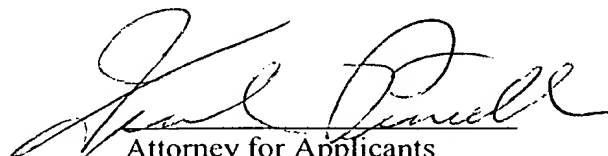
In claim 3 which is dependent upon claim 2, it is taught the providing of the icon that is placed in a marginal area. This is not taught or suggested in any of the references.

Applicant respectfully submits that the Final rejection was premature. The Examiner has recited new grounds of rejections for the claims. As set forth in M.P.E.P. 706.07a "under present practice, second or any subsequent actions on the merit should be final, except where the Examiner introduces a new grounds of rejection not necessitated by amendment of the application by applicant, whether or not the prior art is already of record."

In the instant application, new grounds of rejections were presented which were not necessitated by applicants response. The amendments to the claims made in applicants prior response were amended primarily for clarification and not with regard to the specific scope of the claim. Thus, the new grounds of rejection presented by the Examiner should not have resulted in a Final rejection. Accordingly, applicant respectfully requests that the Final rejection be withdrawn.

In summary, applicant respectfully submit that the claims in present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Frank Pincelli', written over a horizontal line.

Attorney for Applicants  
Registration No. 27,370

Frank Pincelli/djs  
Rochester, NY 14650  
Telephone: (716) 726-1111  
Facsimile: (716) 726-9178